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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JEFF A. LAMBERT, PETE W. AUSTIN,
MICHAEL R. DURHAM, JUAN M. PEREZ, and
KHALDOUN ALZIEN

Appeal 2007-2129
Application 10/808,358¹
Technology Center 2800

Decided: February 5, 2008

Before JOSEPH L. DIXON, ALLEN R. MACDONALD, and
SCOTT R. BOALICK, *Administrative Patent Judges*.

BOALICK, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application filed March 25, 2004. The real party in interest is Hewlett-Packard Development Company, L.P.

This is an appeal under 35 U.S.C. § 134(a) from the final rejection of claims 1-7 and 9-15, all the claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm.

STATEMENT OF THE CASE

Appellants' invention relates to a chassis for an electronic device. Claim 1 is exemplary:

1. A chassis for an electronic device,
comprising:

a plurality of exterior walls joined to each other to form a partially-assembled chassis, wherein at least one exterior wall is entirely vacated; and

a plurality of substantially planar interchangeable access panels each removably attachable to the partially-assembled chassis so as to occupy at least a portion of the exterior wall vacancy, wherein each such access panel has a unique configuration of one or more apertures each providing operational access to components housed in the chassis,

whereby a completely-assembled chassis is attained by removably attaching any of the plurality of interchangeable access panels to the partially-assembled chassis.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Yu	US 6,059,386	May 9, 2000
Yu	US 5,564,930	Oct. 15, 1996

Claims 1-7 and 9-15 stand rejected under 35 U.S.C. § 103(a) as being obvious over Yu '930 and Yu '386.

Rather than repeat the arguments of Appellants or the Examiner, we make reference to the Briefs and the Answer for their respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments that Appellants did not make in the Briefs have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii).²

ISSUE

The issue is whether Appellants have shown that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a). The issue turns on whether there is a legally sufficient reason to combine Yu '930 and Yu '386.

² Except as will be noted in this opinion, Appellants have not presented any substantive arguments directed separately to the patentability of the dependent claims or related claims in each group. In the absence of a separate argument with respect to those claims, they stand or fall with the representative independent claim. *See* 37 C.F.R. § 41.37(c)(1)(vii).

PRINCIPLES OF LAW

All timely filed evidence and properly presented arguments are considered by the Board in resolving an obviousness issue on appeal. *See In re Piasecki*, 745 F.2d 1468, 1472 (Fed. Cir. 1984).

In the examination of a patent application, the Examiner bears the initial burden of showing a *prima facie* case of unpatentability. *Id.* at 1472. When that burden is met, the burden then shifts to the applicant to rebut. *Id.*; *see also In re Harris*, 409 F.3d 1339, 1343-44 (Fed. Cir. 2005) (finding rebuttal evidence unpersuasive). If the applicant produces rebuttal evidence of adequate weight, the *prima facie* case of unpatentability is dissipated. *In re Piasecki*, 745 F.2d at 1472. Thereafter, patentability is determined in view of the entire record. *Id.* However, on appeal to the Board it is an appellant's burden to establish that the Examiner did not sustain the necessary burden and to show that the Examiner erred. *See In re Kahn*, 441 F.3d 977, 985-86 (Fed. Cir. 2006) ("On appeal to the Board, an applicant can overcome a rejection [for obviousness] by showing insufficient evidence of *prima facie* obviousness or by rebutting the *prima facie* case with evidence of secondary indicia of nonobviousness.") (quoting *In re Rouffet*, 149 F.3d 1350, 1355 (Fed. Cir. 1998)).

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said

subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court reaffirmed that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* at 1739. The Court explained that:

When a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or a different one. If a person of ordinary skill can implement a predictable variation, §103 likely bars its patentability. For the same reason, if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill.

Id. at 1740. The Court also explained that:

[o]ften, it will be necessary . . . to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.

Id. at 1740-41. The Court noted that "[t]o facilitate review, this analysis should be made explicit." *Id.* at 1741 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness")). However, "the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *Id.* "Under the correct analysis, any need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed." *Id.* at 1742. The Court cautioned that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning." *Id.*

ANALYSIS

Appellants contend that the Examiner erred in rejecting claims 1-7 and 9-15 as being obvious over Yu '930 and Yu '386. We do not agree. In particular, we find that the Appellants have not shown that the Examiner failed to make a *prima facie* showing of obviousness with respect to claims 1-7 and 9-15. Appellants failed to meet the burden of overcoming that *prima facie* showing.

Regarding claim 1, Appellants argue that there is no suggestion or motivation to combine the teachings of Yu '930 and Yu '386. (App.

Br. 7-14; Reply Br. 1-10.) In particular, Appellants contend that the Examiner failed to provide evidence to support a proper motivation to combine (App. Br. 10-11; Reply Br. 4-5), there is no teaching or suggestion that the advantage articulated by the Examiner would be attained by combining the references (App. Br. 11-13; Reply Br. 5-8), and the combination is based upon impermissible hindsight (App. Br. 13-14; Reply Br. 8-10). We do not agree.

The Examiner correctly found that Yu '930 teaches all limitations of claim 1 except that at least one exterior wall is entirely vacated. (Ans. 3-4.) Among other things, Yu '930 teaches a computer case having a plurality of removable and interchangeable rear panels (50, 90) that enable a designer to incorporate various ports in differing configurations. (Ans. 3; Yu '930 Abstract; col. 3, ll. 42-52; col. 4, ll. 61-65; col. 5, ll. 23-40.)

Additionally, the Examiner correctly found that Yu '386 teaches at least one exterior wall is entirely vacated. (Ans. 3-4; Yu '386 col. 2, ll. 14-19, 43-51.) Among other things, Yu '386 teaches a computer case with a detachable board 20 that includes a front plate 22 which can be used to mount components such as a hard disk, floppy disk, or CDROM drive. (Yu '386 col. 2, ll. 14-19, 43-51.) As shown in Figure 3 of Yu '386, an exterior wall of the computer case is entirely vacated when detachable board 20 is removed.

The Examiner found that, since Yu '386 teaches a removable panel that facilitates the replacement, update, and maintenance of computer equipment (Yu '386 col. 1, ll. 40-42) and thus provides better access to

computer system components (Ans. 4, 7), "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the interchangeable access panel of Yu '930 to include the entire rear panel as taught by Yu '386 to provide better access to the components of the computer system" (Ans. 4; *see also* Ans. 7-9). We agree. In addition, we find that the combined teachings of Yu '930 and Yu '386 would have suggested to one of ordinary skill in the art at the time of the invention the desirability of having interchangeable boards 20 in Yu '386, including front plates 22, for differing component configurations.

Appellants argue that the type of access provided by Yu '930 is not compatible with the type of access taught by Yu '386 and would not result in better access to computer system components (Reply Br. 5-8). We do not agree, and do not find Yu '930 and Yu '386 to be incompatible. Instead, we agree with the Examiner that improved access would result from the combination. In addition, Appellants have presented no evidence that using the removable panel taught by Yu '386 in the computer case of Yu '930 would be uniquely challenging or difficult for one of ordinary skill in the art. Furthermore, we do not find that the Examiner used impermissible hindsight reasoning. In short, there is no evidence that Appellants have done anything more than combine familiar elements according to known methods to yield predictable results.

Appellants also argue that neither Yu '930 nor Yu '386 disclose an interchangeable access panel, as claimed. (App. Br. 7, 14-15.) In particular, Appellants argue that neither Yu '930 nor Yu '386 disclose "an

interchangeable panel which occupies a portion of the exterior wall vacancy as claimed" (App. Br. 15) but instead "each show panels which occupy the *entire* window vacancy in Yu '930 and the entire wall vacancy in Yu '386" (App. Br. 15).

However, as the Examiner correctly found, claim 1 requires only that the panel occupy *at least a portion* of the exterior wall vacancy. (Ans. 9-10.) Therefore, a panel that occupies the entire window vacancy fully meets this limitation of claim 1. As Appellants admit (App. Br. 15) and the Examiner found (Ans. 9-10), Yu '930 discloses a panel that occupies the entire window vacancy.

Accordingly, we conclude that the Examiner did not err in rejecting claim 1 under 35 U.S.C. § 103(a). Claims 2-7 and 9-15 were not argued separately, and fall together with claim 1.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that the Examiner did not err in rejecting claims 1-7 and 9-15. The rejection of those claims is affirmed.

DECISION

The rejection of claims 1-7 and 9-15 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

Appeal 2007-2129
Application 10/808,358

AFFIRMED

tdl/gvw

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